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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,682	07/21/2003	Joseph A. King	5783	5313

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EXAMINER	
TSOY, ELENA	
ART UNIT	**PAPER NUMBER**
1762	

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/623,682	KING ET AL.	
	Examiner	Art Unit	
	Elena Tsoy	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8-20* is/are pending in the application.

4a) Of the above claim(s) *11 and 13-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8-10 and 12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 July 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Preliminary Amendment

Preliminary Amendment filed on May 27, 2004 has been entered. Claims 1-7 have been cancelled. Claims 8-20 are pending in the application. Claims 11, 13-20 are withdrawn from consideration as directed to a non-elected invention.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 8-17, drawn to a method of making an article for in situ water treatment, classified in class 427, subclass 407.1.

   II. Claim 18-20, drawn to a process of making a silver chloride water treatment composition, classified in class 252, subclass 181.

Distinctness

The inventions are distinct, each from the other because:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process for using the product as claimed can be practiced with another materially different product such as zinc sulfate water treatment composition.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Claim 10 is generic to a plurality of disclosed patentably distinct species comprising applying an adhesive and a water treatment composition simultaneously (Claim 11), the adhesive is applied by: spraying (Claim 12), roll coating (Claim 13, 17), die coating (Claim 14), immersion (Claim 15), knife (Claim 16).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. During a telephone conversation with Mr. Carl Johnson on June 22, 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 8-17, species of claim 12. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Claims 11, 13-17 are withdrawn from further consideration by the examiner as being drawn to a non-elected species.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Specification

7. The disclosure is objected to because of the following informalities: Page 2, line 1 (Amended), "This application is a division of pending application Serial Number 09/707,114, filed 11/05/2000 and claims ..." should be changed to -- This application is a division of pending application Serial Number 09/707,114, filed 11/05/2000, now Patent 6,652,871, and claims ... --.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. **Claims 8, 9** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5, 7, 8 of U.S. Patent No. 6,446,814. Although the conflicting claims are not identical, they are not patentably distinct from each other because Patent '814 discloses a method of making a filter comprising securing a silver chloride to a filter medium having a network (a web) using an adhesive.

10. **Claims 10, 12** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5, 7, 8 of U.S. Patent No. 6,446,814 In view of Rosenblatt (US 6,365,169).

Patent '814 fails to teach that the adhesive is polyvinyl acetate (PVA) (Claim 10) and is applied by spraying (Claim 12).

Rosenblatt teaches that PVA adhesives together with iodine and other antimicrobial components (See column 6, lines 36-44) can be used in making water filters and can be applied by spraying (See column 8, lines 1-11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used PVA as an adhesive in Patent '814 together with iodine and applied by spraying since Rosenblatt teaches that PVA adhesives together with iodine and other antimicrobial components can be used in making water filters and can be applied by spraying.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. **Claims 8, 9** are rejected under 35 U.S.C. 102(b) as being anticipated by KR 8902848.

KR 8902848 discloses a method of making a sterilizing and water-cleaning filter comprising coating a permeable nonwoven fabric with an adhesive and adhering to the coated fabric silver-added (particulate) active carbon (a metal yielding material) (See Abstract).

The Examiner's Note: clearly, it is implied that adhesive was allowed to dry.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims **10, 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over KR 8902848 in view of Rosenblatt (US 6,365,169).

KR 8902848 fails to teach that the adhesive is polyvinyl acetate (PVA) (Claim 10) and is applied by spraying (Claim 12).

Rosenblatt is applied here for the same reasons as above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used PVA as an adhesive in KR 8902848 together with iodine and applied by spraying since Rosenblatt teaches that PVA adhesives together with iodine and other antimicrobial components can be used in making water filters and can be applied by spraying.

It is the Examiner's position that placement of the filter of KR 8902848 in view of Rosenblatt into a body of water would enable the structure to adhesively support the water treatment material thereon in a condition that maintains a water concentration of metal ions less than 1000 parts per billion (ppb) since it is produced by a method identical or substantially identical processes to that of claimed invention.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur. 9:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ET Tsoy

Elena Tsoy
Primary Examiner
Art Unit 1762

June 28, 2004